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EXAMINER

JACOBSON, MICHELE LYNN

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Request for Reconsideration

Applicant has argued on page 6 of the remarks submitted 11/12/09 that Heyenk cannot anticipate the claimed composition because 37% is the highest concentration of polyester having a T_g less than about 25°C specifically disclosed. However, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” In re Courtright, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Applicant wrongly construes the teaching in an example of a polyester blend comprising 37% of a polyester having a T_g less than about 25°C to infer that one of ordinary skill would not have reasonably surmised that the blend recited by Heyenk to comprise at least 25% of a polyester with a T_g higher than 45°C would comprise up to 75% of a polyester with a T_g of less than 25° C in the remainder. On page 7 of the remarks applicant states “the other 75% of the blend **could** include one or more materials other than a polyester polymer having a T_g of less than about 25°C”. (emphasis added) Whether or not such an embodiment “could” exist does not detract from the fact that one of ordinary skill would have reasonably interpreted a disclosure of a resin comprising a mixture of at least two polyester polymers, one having a glass transition temperature of greater than about 45° C in an amount of at least 25% and a second having a glass transition temperature of less than 10° C to mean that in the two polyester polymer embodiment that that second component would comprise 75% of the blend. Furthermore, “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of

Art Unit: 1794

these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Applicant asserts on page 7 of the remarks that Heyenk does not specifically disclose any polyester resins having a T_g of greater than 50°. However, this does not address the arguments presented in the rejection that the disclosure of a polyester resin having a T_g within the open ended range of greater than 45° is sufficiently specific to anticipate applicants claimed open ended range. Applicant further asserts that Heyenk does not provide an enabling disclosure for such a polymer even though it falls within the ranges of T_g recited by Heyenk. Absent any evidence or specific arguments as to why one of ordinary skill in the art would not have been able to undertake the routine experimentation necessary to produce a polyester within the range of T_g disclosed by Heyenk the examiner is not persuaded by applicant's assertions.

/M. J./

Examiner, Art Unit 1794

/Rena L. Dye/
Supervisory Patent Examiner, Art Unit 1794